REMARKS

Claims 1-3 and 10-18 are pending in this application. By this amendment, claim 11 is amended. Reconsideration of the present application based on the above amendments and the following remarks is respectfully requested.

Entry of the amendments is proper under 37 C.F.R. §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments simply make a former independent claim dependent on another independent claim; (c) do not present any additional claims; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not presented earlier because they are made in response to the Restriction Requirement put forth in the December 15, 2004 Office Action, and are believed to facilitate and expedite examination. Entry of the amendments is thus respectfully requested.

However, if the amendments are not entered, Applicants respectfully traverse the Restriction Requirement between Groups I and II.[1] The Office Action asserts that Group I and Group II are distinct from each other because:

> Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP §806.05(f)). In the instant case process as claimed can be used to make other and

[1] In paragraph 1 of the Office Action, the Office Action restricts the claims to Group I, claims 1-3, 10 and 11-18; and Group II, claim 11. In paragraph 7, the Office Action withdraws claim 10 from consideration. It is respectfully submitted that both paragraphs contain an error. Specifically, it appears that Group I is intended to include claims 1-3, 10 and 12-18; and Group II is intended to include claim 11. Thus, it is believed that claim 11 is withdrawn from consideration. In response to the Office Action, Applicants assume that the December 15, 2004 Office Action restricted claim 11 only to Group II; and thus withdrew only claim 11 from consideration.

materially different product such as a sol comprising additional components that excludes lanthanum and neodymium (emphasis added).

Applicants respectfully submit that this assertion is baseless and illogical. Specifically, it is illogical to assert that a method as claimed in claim 11, which specifically recites making an abrasive which comprises as an additional component "a lanthanum compound, a neodymium compound or a combination thereof," can be used to make a product such as "a sol comprising additional components that excludes lanthanum and neodymium." In other words, the claim cannot both include and exclude a given step or element. As such, if the amendment to claim 10 is not entered, Applicants respectfully request withdrawal of the Restriction Requirement and rejoinder and examination of claim 11 in its former state.

The Office Action rejects claims 1-3, 10 and 12-18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,769,073 to Tastu et al. in view of U.S. Patent No. 6,171,572 to Aozasa. This rejection is respectfully traversed.

The applied combination of references does not disclose a sol in which particles are dispersed in a medium, wherein the particles have a particle size of 50 to 150 nm and comprise as a main component crystalline cerium oxide of the cubic system and as an additional component a lanthanum compound, a neodymium compound or a combination thereof, as claimed in claim 1, and similarly claimed in claim 10.

The Office Action admits that Tastu fails to disclose a particle size of 50 to 150 nm. However, the Office Action asserts that Aozasa makes up for the deficiencies of Tastu, and asserts that because Aozasa discloses that if the average colloidal particle size is smaller than 3 nm production in industrial scale will be difficult, it would have been obvious to modify the abrasive materials as taught by Tastu with the teaching of Aozasa's sol.

However, this assertion misrepresents Aozasa. Aozasa discloses:

> If the average colloidal particle size is smaller than 3 nm, production in industrial scale will be difficult. If the average colloidal particle size is larger than 100 nm, the colloidal particles do not compound zirconium oxide easily in the later process. (Col. 5, lines 59-63.)

As such, Aozasa discloses an average colloidal particle size between 3 nm and 100 nm is necessary to compound zirconium oxide easily. Thus, it is because Aozasa is intended to compound zirconium oxide that Aozasa discloses a colloidal particle size between 3 nm and 100 nm.

Claims 1 and 10, on the other hand, are not directed to compounding colloidal particles to zirconium oxide. As such, one of ordinary skill in the art would have viewed Aozasa's particle size as irrelevant to the context of Tastu, and therefore would not have been motivated to modify the sol of Tastu by using the particle size as disclosed by Aozasa.

Accordingly, it respectfully submitted that the applied art fails to anticipate or render obvious the features of claims 1 or 10. Furthermore, those claims which depend from claims 1 or 10 are likewise distinguishable over the applied art for at least the reasons discussed above, as well as for additional features they recite. Accordingly, withdrawal of the rejections under 35 U.S.C. §103(a) is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Jude L. Cooney
Registration No. 54,045

JAO:JLC/aaw

Date: **March 15, 2005**

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE AUTHORIZATION
Please grant any extension necessary for entry;
Charge any fee due to our Deposit Account No. 15-0461